

REMARKS/ARGUMENTS

Applicant responds herein to the Office Action dated 13 June 2006.

At the outset, Applicant gratefully acknowledges the withdrawal of the rejections set forth in the previous Office Action. Applicant's attorneys appreciate the Examiner's thorough search and examination of the present patent application.

Claims 12-15 are pending in this application. All claims are rejected.

In the most recent Office Action, claims 12-15 stand rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Publication No. 2004/0061793 to Fellegara et al. (Fellegara) in view of U.S. Patent No. 6,049,371 to Manico et al. (Manico), U.S. Publication No. 2004/0218833 to Ejiri, et al. (Ejiri) and U.S. Patent No. 6,049,371 to Durrani (Durrani). Applicant respectfully traverses the rejection for at least the reasons set forth below.

Independent claim 12 recites an electronic camera comprising, *inter alia*, a display panel, an image discrimination circuit, a display mode setting circuit, and a display circuit, wherein when the image discrimination circuit determines a selected image as representing a panoramic image based on the aspect ratio of the selected image, the display mode circuit sets a panoramic display mode, and the display circuit displays on the display panel a selected frame of the panoramic image. The Office Action at p. 5 avers that Fellegara discloses, at Figure 6, a display circuit as recited in claim 12, or alternately that such a circuit is inherent. Applicant respectfully disagrees.

Fig. 6 of Fellegara illustrates a schematic of the system architecture of the camera system of Fellegara Fig. 1. Fig. 6, without more, does not teach or suggest that any display circuit as may be present in Fig. 6 of Fellegara displays on the display panel a selected frame of the panoramic image, nor that any display format for the image is determined by the image discrimination circuit, as recited in claim 12. To the contrary, and with reference to Fellegara Figs. 13A-13D and their accompanying description, the reference teaches that the entire digital image is shown in the display (Fig. 13A), and a user may select a mask to apply to the digital image so that it is subsequently displayed in one of four formats. In the case where the user selects a panoramic format (Fig. 13C), the display does not show a selected frame of the panoramic image, but rather the entire panoramic image.

Therefore, according to Fellegara, the selection of display format is not selected by a display-mode setting circuit according to an image discrimination circuit, it is selected by the user. Additionally, once the user designates the image as a panoramic image, it is not displayed in the display by a display circuit as only a selected frame of the image, rather the entire panoramic image is displayed.

Further, Applicant respectfully disagrees with assertion in the Office Action that Fellegara inherently discloses a display circuit configured to cause the selected image to be displayed on the display panel according to the display-mode set in the display-mode setting circuit, and that the display circuit displays on the display panel a selected frame of the panoramic image when an image discrimination determines a selected image represents a panoramic image. It has been held by the courts that to support a *prima facie* case of anticipation by inherency, the limitation in question must “necessarily” be present in the prior art reference. *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999). “A claim limitation is inherent in the prior art if it is necessarily present in the prior art, not merely probably or possibly present.” *Akamai Technologies, Inc. v. Cable & Wireless Internet Services, Inc.*, 344 F.3d 1186, 68 USPQ2d 1186 (Fed. Cir. 2003). Moreover, “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). In the present case, there is no basis to support the assertion that a display circuit configured as recited in claim 12 is *necessarily* present in Fellegara. To the contrary, as noted above, the reference itself teaches that the display function is very different.

The Office Action further alleges that Fellegara teaches a frame-advance button for advancing the plurality of frames of the panoramic image into the display panel. Applicant respectfully disagrees. In contrast to claim 12, Fellegara teaches advancing among different images, not among a plurality of frames of the same selected panoramic image.

The supporting references, Manico, Ejiri or Durrani, taken singly or in any combination with each other or Fellegara, do not offer, nor are they alleged to, any teaching or suggestion to ameliorate the deficiencies of Fellegara with respect to the above-referenced elements of claim 12.

The Office Action alleges that Ejiri teaches that panoramic images consist of multiple frames that partially overlap, with the amount of overlap presented to the user in each screen. Applicant respectfully disagrees. Ejiri is directed to the creation of such panoramic images, not to the display of a completed panoramic image stored in a removable memory of the digital camera. Ejiri discloses that as a camera is moved, to create subsequent frames to be later amalgamated into a panoramic image, the amount of displacement from one image to the next is displayed on the screen. In contrast, the claim recites that a selected frame of a panoramic image already stored in the removable memory of the digital camera is displayed. Therefore, Ejiri does not ameliorate the deficiencies of Fellegara with respect to claim 12.

It is well settled that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). As discussed about the cited references, taken singly or in any combination, neither teach nor suggest all features of claim 12. Therefore, Applicant respectfully submits that claim 12 is patentably distinguished over the cited references, and that the rejection has been obviated.

The Office Action alleges that it would have been obvious to combine Fellegara with Manico, to automatically classify an image and display it in panoramic mode. This does not follow from the references, because as noted above, the relevant portion of Fellegara is provided to allow the user to selectively choose a panoramic image from among other types of images that may be composed from the underlying digital image. To combine the two references as proposed in the Office Action would be to render the image format selection a feature of Fellegara inoperative, not automate it. “If when combined, the references ‘would produce a seemingly inoperative device,’ then they teach away from their combination.” *Tec Air Inc. v. Denso Manufacturing Michigan Inc.*, 192 F.3d 1353, 52 USPQ2d 1294 (Fed. Cir. 1999). Therefore, the proposed motivation to combine the references is lacking. In the absence of motivation to combine the references, the rejection is poorly taken. Applicant kindly requests favorable reconsideration and withdrawal.

Turning to independent claim 14, notwithstanding the differences between it and claim 12, the Office Action incorporates the rejection of claim 12 by reference, including the deficiencies as noted above. Therefore, the rejection of claim 14 is equally lacking, and should


be withdrawn. Claims 13 and 15 depend from independent claims 12 and 14, respectively. This claims are each separately patentable, but are offered as patentable for at least the same reasons as their underlying independent base claims.

In the interest of brevity, Applicant has addressed only so much of the rejection as is considered sufficient to demonstrate the patentability of the claims. Applicant's failure to address any part of the rejection should not be construed as acquiescence in the propriety of such portions not addressed. Applicant maintains that the claims are patentable for reasons other than these specifically discussed, *supra*.

Accordingly, the Examiner is respectfully requested to reconsider the application, allow the claims as amended and pass this case to issue.

Respectfully submitted,

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